

Application/ Control No.: 10/624,002
Examiner: GOLOBOY, James C

REMARKS

The Examiner is thanked for entering the submission filed June 4, 2009.

In paragraph 3 of the Office Action, claims 1, 3, 7, 11-12 and 14-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kageyama in view of Wulfers. Claim 13 was rejected under 35 U.S.C. §103as being unpatentable over Kageyama in view of Wulfers and further in view o9f Minami.

Reconsideration is requested.

Claims 1, 7, 13, 14 and 15 have been amended to correct typographical errors. The term "nitrate" been corrected to read "nitrite" in accordance with the specification at page 17, line 15. A recitation of the presence of a rust preventative has been added to claims 1,14 and 15 in accordance with page 15, line 16 et seq. New claim 16 points out the invention in terms that are similar to claim 1 but claim 16 specifically recites the range of worked penetration in accordance with the Examples of Table 1.

The Examiner has previously applied the Kageyama reference as teaching a grease comprising an alkydiphenylether oil and a diurea thickner having a structure meeting the limitations of claim 1. The Wulkfers patent was applied as follows:

"[T]he sodium sebacate anticorrosion additive of Wulfers we and one of ordinary skill in the art would have a reasonable expectation of success in using it in the grease of Kageyama."

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The amended claims point out that a specific rust preventive is present, namely a partially esterified multivalent alcohol or an organic sulfonic acid salt of an alkali metal or an alkali earth metal. Neither Kageyama nor Wulfers disclose these rust preventives.

The data in the specification has been dismissed by the Examiner based on the concentrations tested. However, in the present case, the Examiner has deemed the prior art as imparting to a skilled worker in the art a reasonable expectation of success in using Wulfers' sodium sebacate. Wulfers is silent as to any disclosure of a reasonable expectation of success in using the sodium sebacate in the manner that the Examiner has deemed to be obvious. In fact, Wulfers teaches away from combining the sodium sebacate with organic grease thickeners as they "do not afford the extended operating lifetimes as measured by thermal and mechanical stability at high temperatures" (col. 1, lines 53-56). Thus the negative teaching against the use of the organic thickeners, is persuasive that the combined teachings of Wulfers and Kageyama fail to establish a *prima facie* case of obviousness.

Wulfers' invention is related to a triazine urea compound that acts as a thickening agent and that compound is not an aromatic urea because the heterocyclic triazine ring is not an aromatic ring. In addition, the formula of claim 1 of Wulfers has an R group which is an aliphatic hydrocarbyl group of 16-22 carbon atoms. Since the triazine urea of Wulfers is distinctly different from the aromatic diurea of the present invention, the combination of the triazine urea compound and the sodium sebacate of Wulfers cannot suggest the combination of the aromatic diurea and sodium sebacate

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according to the claims of the present application. The data of record which points out that grease compositions within the claims when used with a sealed bearing provide excellent results in the high-temperature and high-speed test, the sudden acceleration/deceleration test and the rust preventive test is persuasive of the non-obviousness of the claimed invention.

The Examiner has responded to the applicants' prior arguments regarding the negative teachings of Wulfers by arguing that they cannot be considered as applying to Kageyama. Thus the Examiner ignores a negative teaching in Wulfers but relies on Wulfers' teachings that relate to sodium sebacate as making obvious the use of sodium sebacate with the agents of Kageyama when Wulfers would not combine sodium sebacate with the urea thickeners of Kageyama. This argument points up the fact that only in the present specification does one find the combination of the specific dialkyl phenyl ether oil, the urea thickener, sodium sebacate and the specific rust preventives of the amended claims.

The data of the Examples and the Comparative Examples are believed to be commensurate with the amended claims which all recite the presence of a rust preventive agent and sodium sebacate. The test data demonstrates that the presence of the combination barium sulfonate (a organic sulfonic acid salt of an alkali metal) or sorbitan trioleate (a partially esterfied multivalent alcohol) in the absence of sodium sebacate provides a rust preventive effect but inferior performance regarding speed and acceleration testing. This data is based on the presence or absence of the sodium sebacate component. The Examiner in paragraph 5 of the Office Action noted that Wulfers teaches that some conventional urea-thickened greases

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do not have long lifetimes at high temperatures. Wulfers teaches that the solution to high temperature longevity is to use his triazine based thickener and one must disregard Wulfers if one uses the claimed urea based thickener recited in the claims of the present application. The mention of sodium sebacate by Wulfers is only in connection with the triazine based thickener and the only source of information to use sodium sebacate in combination with the aromatic diurea compound is found in the applicants' specification.

Minami discloses a grease that employs a non-aromatic diurea compound without any mention of sodium sebacate. Rust preventive agents are mentioned but the combination claimed by the present application is not made obvious by Minami alone or in combination with Kageyama or Wulfers.

Favorable consideration and early allowance are respectfully requested and earnestly solicited.

Respectfully submitted,



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